

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 9, 2005. At the time of the Final Office Action, Claims 1, 3-5, 7-9, 11, 13-15, 17-19, 21, 24, 27 and 28 were pending in this Application. Claims 11, 3-5, 7-9, 11, 13-15, 17-19, 21, 24, 27 and 28 were rejected. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1, 3-5, 7-9, 11, 13-15, 17-19, 21 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,987,249 issued to Franklin C. Grossman et al. (“Grossman et al.”) in view of U.S. Patent 6,513,154 issued to John R. Porterfield (“Porterfield”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 27 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Grossman et al. and Porterfield as applied to Claims 1 and 11 above, and further in view of U.S. Patent 5,784,621 issued to Yasushi Onishi et al. (“Onishi et al.”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Examiner stated in particular that Porterfield discloses a system with an editing device that allows for marking of an area of the control program for debugging purposes

wherein the compiler produces machine independent code which contains debug information for the marked area. Applicants respectfully disagree.

Porterfield discloses a method of instrumenting program code for debugging purposes. However, the system disclosed by Porterfield does not provide for the feature of an editor that allows for marking a specific area wherein the compiler then only provides debugging information for that area. Porterfield discloses an automated system which checks the development of a complex software project. In such a system, a user can merely select an option that restricts the analyzing device to code that has been recently edited by a user or has been changed by the system. Thus, the Porterfield system can avoid instrumentation of code that has already been successfully tested. However, a user does not have the option of actually choosing a specific area of a program code to be provided with debug information. This has a plurality of benefits in particular in the field of automation systems consisting of an engineering system and a runtime system as disclosed and claimed in the present invention.

In an automation system, there are, for example, situations in which a specific code segment operates perfectly fine. However, in combination with specific hardware such as in a production machine that is controlled by the control program, certain control functions might generate a wrong result due to the characteristic of the overall system. According to the present invention, a user has the possibility to actually mark a specific section of a control program which might be at issue. The system, will then only generate debug information for that specific section.

Porterfield does not allow for such a selection. In fact, Porterfield does not even provide for any selection option through an editor. According to Porterfield, a user can merely narrow the production of instrumentation for a code that has been edited or changed by the system. However, this determination, namely which part of the program has been edited or changed, is made automatically by the system. Porterfield neither discloses nor suggests to allow a user to specifically mark an area of a control program which will then be provided with debugging information.

Therefore, Applicants respectfully request allowance of the independent claims 1 and 11. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claims 1 or 11 to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35

U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be directed to Customer No. **31625** and all telephone calls should be directed to Andreas Grubert at 512.322.2545.

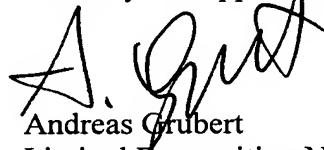
CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of remarks set forth above. Applicants respectfully request reconsideration of all pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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